



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,769	04/13/2001	John L. Robertson	2693	3757

7590 10/30/2002

Walter A. Hackler, Ph.D
Attorney of Record
Suite B
2372 S.E. Bristol
Newport Beach, CA 92660-0755

EXAMINER

ALEXANDER, LYLE

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 10/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,769

Applicant(s)

ROBERTSON ET AL.

Examiner

Lyle A Alexander

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

Claim Rejections - 35 USC § 112

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 "portion defining a pocked sized" is vague and indefinite as to what structure and size is being claimed. Clarification could be achieved by replacing "portion defining a pocked sized" with --chamber--. Similarly, claim 12 could be clarified by replacing "pocket portion" with --chamber--.

Both independent claims 1 and 12 use the term "feed element" which could be clarified by --sample control/metering/supplying/etc. means--.

Claim 6 is directed to a method of intended use and does not further limit the structure of the claimed device.

Claims 8 and 17 are vague and indefinite as to how many feed inlets are contemplated by "between about 5 and about 7". For the purpose of examination, this will be considered as 6 feed inlets. Applicants must delete the term "about" in this claim or change the language to 6 feed inlets.

Claims 11 and 20 are not clear what structure is contemplated by "a rail depending from a perimeter portion...".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1743

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-3,5-7 and 10-11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kang et al.(USP 5,559,041), May et al.(USP 5,656,503), Shuler et al.(USP 5,798,273), Kang et al. (USP 6,027,943), Chandler (USP 5,468,648) or Kuhn et al. (USP 5,202,268).

All of these references teach the claimed features of a casing, a "pocket" to contain the sample and means to distribute the sample to testing assemblies.

Claims 1-3,5-8,10-14,16-17 and 19-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Chipowski (USP 5,976,895).

Chipowski teaches an analytical test device that includes a top(22) interlocking with cup(11) that has been read on the claimed "casing". Chipowski teaches test card (25) comprising test strips(26-30) which has been read on the claimed "pocket portion ... feed elements... plurality of test elements". Chipowski teaches 5 test strips plus one control which have been read on the claimed "between about 5 and about 7 feed inlets".

Claims 1-3,5-8,10-14,16-17 and 19-20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Lu et al.(USP 6,203,757).

Art Unit: 1743

Lu et al. teach an analytical test device that includes a face plate(22) interlocking with base(23) that has been read on the claimed "casing". Lu et al. teaches port/hole(24) interconnected with distribution web(25) and test strips(26a-e) which have been read on the claimed "pocket portion ... feed elements... plurality of test elements". It is noted Lu et al. teaches 6 test strips that has been read on the claimed "between about 5 and about 7 feed inlets".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 1743

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4,9,15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chipowski or Lu et al.

See Chipowski and Lu et al. *supra*.

The cited prior art is silent to the claimed spacing of the feed inlet slots/diameters of 0.050 inches.

It is well settled that changes in size/proportion are within the skill of the art (see In re Rose, 105 USPQ 237 or In re Reven, 156 USPQ 679).

It would have been within the skill of the art to modify Chipowski or Lu et al. and space the feed inlet slots/diameters at 0.050 inches as obvious changes in size/proportion.

Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang et al.(USP 5,559,041), May et al.(USP 5,656,503), Shuler et al.(USP 5,798,273), Kang et al. (USP 6,027,943), Chandler (USP 5,468,648) or Kuhn et al. (USP 5,202,268).

The cited prior art is silent to the claimed spacing of the feed inlet slots/diameters of 0.050 inches.

It is well settled that changes in size/proportion are within the skill of the art (see In re Rose, 105 USPQ 237 or In re Reven, 156 USPQ 679).

Art Unit: 1743

It would have been within the skill of the art to modify Kang et al.(USP 5,559,041), May et al.(USP 5,656,503), Shuler et al.(USP 5,798,273), Kang et al. (USP 6,027,943), Chandler (USP 5,468,648) or Kuhn et al. (USP 5,202,268) and space the feed inlet slots/diameters at 0.050 inches as obvious changes in size/proportion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 703-308-3893. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9319 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Lyle A Alexander
Primary Examiner
Art Unit 1743

October 28, 2002